PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	)	
	)	
John G. McBride	)	Group Art Unit: 2825
	)	
Serial No.: 09/311,313	)	Examiner: Leigh Marie Garbowski
	)	
Filed: May 13, 1999	)	
	)	
For: METHOD AND APPARATUS FOR DETERMINING WHETHER AN ELEMENT IN AN INTEGRATED CIRCUIT IS A FEEDBACK ELEMENT	)	HP Ref. 10971316 TKHR Ref. 50814-1550

Certificate of Mailing
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Petition; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 15, 2004.

Signature - Brooke French

PETITION TO WITHDRAW HOLDING OF ABANDONMENT
OR IN THE ALTERNATIVE
PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Notice of Abandonment (mailed September 22, 2004) has been carefully considered. In response thereto, please consider the following remarks.

FACTS

The above-referenced patent application went through an appeal, and a decision on appeal was mailed May 26, 2004. The decision on appeal sustained the examiner's rejections of independent claims 1, 14, and 29. Dependent claims 2-13, 15-18, and 20-22 were indicated as allowable, and were therefore at issue in the appeal.

On June 29, 2004, within the two-month period for replying to the decision on appeal, the undersigned submitted an amendment after decision on appeal. This amendment merely copied and pasted the language of allowable claims into each of the rejected independent claims. For example, the language of allowable claim 2 was copied and pasted into claim 1, to place independent claim 1 in condition for allowance. Dependent claim 2 was, correspondingly, cancelled. Similar amendments were made to the other two independent claims. This amendment was made to place this application in condition for allowance.

However, rather than enter these amendments, the patent office refused entry of the amendment stating that the proposed amendments would at least be subject to objections or rejections under 112, second paragraph. The undersigned was not made aware of this until September 28, 2004, which was the date upon which a Notice of Abandonment was received from the PTO.

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

The Code of Federal Regulations and the MPEP clearly provide the right for Applicants to make amendments after appeal, in order to place an application in condition for allowance. No situation is more appropriate for such an amendment than that of the present application. In this regard, the present application had all dependent claims indicated as allowable, with only the three independent claims standing rejected. The amendment that was made was simple and straightforward, and merely copied and pasted the language of allowable dependent claims into corresponding independent claims.

The basis, however, for refusing to enter this amendment was that the amendment would be "subject to objections and 35 U.S.C. § 112, second paragraph rejections." However, no particular objection or rejection was cited. That is, the Notice of Abandonment did not indicate any language of the amended claims that was improper. Instead, it appears that the examiner may not have even considered the proposed amendments, and instead simply routinely refused their entry. In view of the fact that this application had numerous allowable claims, and the submitted amendment clearly embodied the Applicant's intention to accept the admittedly allowable claims to place this application in condition for allowance, the examiner should have at least provided the undersigned attorney with the courtesy of a phone call to indicate her unwillingness to enter the amendments and give the undersigned a proper opportunity to submit and RCE (or other continuing) application to avoid such abandonment. The abandonment of this application has now created unnecessary work on the part of the PTO to consider the present submission.

Stated another way, if the rationale for the examiner is accepted, there is simply no situation in which any amendment submitted after a decision on appeal could not be said to raise potential 112, second paragraph issues. Such a result would necessitate the filing of a continuation application in response to every Decision on Appeal (even to ensure the entry of such minor amendments). The fact, however, that the rules (both the CFR and the MPEP) clearly provide for the appropriateness of such amendments, should necessitate a good-faith evaluation on the part of the examiner to at least identify specifically-objectionable material before entering a Notice of Abandonment, as was done in the present case. For at least this reason, the undersigned respectfully requests and hereby petitions that the Notice of Abandonment be withdrawn, without any charge to the Applicant.

Accompanying this submission, the undersigned attorney has submitted an RCE transmittal (with appropriate filing fee payment) along with instructions for the examiner to enter the previously unentered amendment, and as such respectfully submits that this application is now in condition for allowance.

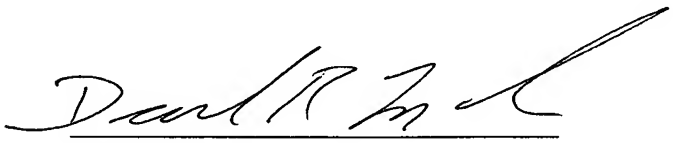
PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION

If, however, the undersigned's above Petition to Withdraw Holding of Abandonment is not granted, the undersigned hereby petitions the PTO to revive this application for unintentional abandonment. It is clear from the submission of the amendment after the decision on appeal that the Applicant did not intend for this application to become abandoned. Indeed, that timely submission embodied a clear intent on the part of the Applicant to make only cosmetic amendments to place admittedly-allowable subject matter in condition for allowance. The Applicant and undersigned reasonably relied on specific provisions within the governing rules and regulations that allow for such amendments, in connection with their previous submission. In this regard, the rules do not require that any amendment after a decision on appeal be accompanied by a new filing fee and a continuation application. As such, no such filing was believed to be necessary or appropriate.

Accordingly, the abandonment of this application was clearly unintentional and, if the PTO is not inclined to withdraw the holding of abandonment at no charge, then the undersigned hereby petitions that the PTO revive this application for unintentional abandonment. As such, the PTO is hereby authorized to debit 20-0778 for the requisite petition fee, and any other fee that may be required in connection with this Petition to Revive an Unintentionally Abandoned Patent Application.

Statement. The abandonment of this application was unintentional (for reasons set for above), and this petition was promptly filed upon receiving the Notice of Abandonment.

Respectfully submitted,



Daniel R. McClure
Registration No. 38,962

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500